

REMARKS

Claims 1-71 are pending in this application.

Applicants' undersigned representative appreciates the Examiner's courtesy extended during the telephonic interview conducted on November 25, 2005. Applicants' undersigned representative concurs with the substance of the interview set forth in the Interview Summary mailed on November 30, 2005.

Applicants respectfully request reconsideration of the rejection of claims 1, 2, 5-11, 18-21, 26-29, 52-54, 57-65, 67, and 69-71 under 35 U.S.C. § 102(b) as being anticipated by *Shiota et al.* (U.S. Patent No. 6,011,547). As will be explained below, the *Shiota et al.* reference does not disclose each and every feature specified in independent claims 1, 18, 26, 52, 57, 61, 62, 64, 67, 69, and 71.

The above-listed independent claims include, in the context of an apparatus, a method, a computer program product, etc., image process control information, which controls image processing at the output device. The *Shiota et al.* reference does not disclose the use of such image process control information, but instead describes the use of recording information. As described in the *Shiota et al.* reference, the "recording" information includes information specific to the camera and information which varies at each recording depending on the environment or the photographer (see column 2, lines 19-32). As such, the recording information described in the *Shiota et al.* reference is different from the image process control information specified in the claims.

In support of the anticipation rejection, the Examiner refers to recording information 9 and processing condition 10 shown in Figure 1 to argue that the *Shiota et al.* reference discloses image process control information as in the claimed subject matter. Based solely on Figure 1, the Examiner's position appears to be reasonable. It is evident from the specification and claims in the *Shiota et al.* reference, however, that the illustration of Figure

1 is inaccurate. In the *Shiota et al.* system, the processing conditions added to the digital image data are first used by an image reproducing apparatus for image processing, and the processing conditions are not something that is transmitted, together with image data, from devices such as a digital camera and an image server. This characterization of the *Shiota et al.* reference is supported by the description provided at column 2, lines 56-65, and column 3, lines 26-44, and claims 2 and 4. In particular, from the description provided at column 3, lines 26-44, it is evident that a digital camera adds recording information to image data, and that the image reproducing apparatus can add an optimal image processing condition obtained through, e.g., processing of the image data.

Applicants respectfully submit that any reasonable characterization of the *Shiota et al.* reference must consider the specification as a whole. In this regard, the *Shiota et al.* reference does not describe image server 2 in any significant detail. When the specification is considered as a whole, Applicants submit that image file 7 shown in Figure 1 should be interpreted as an image file that includes image data and an image processing condition that has been added to the image data by the image reproducing apparatus. As such, Applicants submit that the *Shiota et al.* reference does not disclose a system that uses image process control information as in the claimed subject matter.

With regard to independent claims 18, 52, and 67, Applicants note that these claims include features specified using means-plus-function language and that the Examiner has not provided the analysis required by 35 U.S.C. § 112, sixth paragraph. Accordingly, Applicants respectfully submit that the Examiner has failed to make a *prima facie* showing that the *Shiota et al.* reference anticipates the subject matter specified in claims 18, 52, and 67.

Accordingly, for at least the foregoing reasons, independent claims 1, 18, 26, 52, 57, 61, 62, 64, 67, 69, and 71 are patentable under 35 U.S.C. § 102(b) over *Shiota et al.* The claims depending from the above-listed independent claims are likewise patentable under 35

U.S.C. § 102(b) over *Shiota et al.* for at least the same reasons set forth regarding the applicable independent claim.

Applicants respectfully request reconsideration of the rejection of claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over *Shiota et al.* in view of *Liu et al.* (U.S. Patent No. US 6,523,046 B2). The deficiencies of the *Shiota et al.* reference relative to independent claim 1, from which claims 3 and 4 ultimately depend, are set forth above in the connection with the discussion of the anticipation rejection based on the *Shiota et al.* reference. The *Liu et al.* reference does not cure the above-discussed deficiencies of the *Shiota et al.* reference relative to claim 1. Accordingly, claims 3 and 4 are patentable under 35 U.S.C. § 103(a) over the combination of *Shiota et al.* in view of *Liu et al.* for at least the same reasons set forth above regarding claim 1.

Applicants respectfully request reconsideration of the rejection of claims 12-17, 22-25, 30-36, 47-51, 55, and 56 under 35 U.S.C. § 103(a) as being unpatentable over *Shiota et al.* in view of *Telle* (U.S. Patent No. 5,105,266). The *Telle* reference, which is cited to show the converting of colors from one color space to an absolute color space, does not cure the above-discussed deficiencies of the *Shiota et al.* reference relative to the claimed subject matter. Thus, the combination of *Shiota et al.* in view of *Telle* would not have suggested to one having ordinary skill in the art the subject matter defined in claims 12-17, 22-25, 30-36, 47-51, 55, and 56.

Further, with regard to independent claims 22 and 55, Applicants note that these claims include features specified using means-plus-function language and that the Examiner has not provided the analysis required by 35 U.S.C. § 112, sixth paragraph. Accordingly, Applicants respectfully submit that the Examiner has failed to make a *prima facie* showing that the combination of the *Shiota et al.* and *Telle* references would have rendered the subject matter specified in claims 22 and 55 obvious to one having ordinary skill in the art.

Accordingly, for at least the foregoing reasons, claims 12-17, 22-25, 30-36, 47-51, 55, and 56 are patentable under 35 U.S.C. § 103(a) over *Shiota et al.* in view of *Telle*.

Applicants respectfully request reconsideration of the rejection of claim 37 under 35 U.S.C. § 103(a) as being unpatentable over *Shiota et al.* in view of *Telle* and *Liu*. Claim 37, which depends from claim 34, is patentable over the asserted combination of references for at least the reason that this claims depends from claim 34.

Applicants respectfully requests reconsideration of the rejection of claims 38-42 and 44-46 under 35 U.S.C. § 103(a) as being unpatentable over *Shiota et al.* in view of *Kondo*. Neither the *Shiota et al.* reference nor the *Kondo* reference discloses or suggests the use of image process control information as in the claimed subject matter. Accordingly, independent claim 38 and claims 39-42 and 44-46 that ultimately depend therefrom are patentable under 35 U.S.C. § 103(a) over *Shiota et al.* in view of *Kondo*.

Applicants respectfully request reconsideration of the rejection of claims 66 and 68 under 35 U.S.C. § 103(a) as being unpatentable over *Shiota et al.* in view of *Telle* and *Kondo*. Neither the *Telle* reference nor the *Kondo* reference cures the above-discussed deficiencies of the *Shiota et al.* reference relative to the claimed subject matter. In addition, Applicants note that claim 68 includes features specified using means-plus-function language and that the Examiner has not provided the analysis required by 35 U.S.C. § 112, sixth paragraph. Accordingly, for at least the foregoing reasons, claims 66 and 68 are patentable under 35 U.S.C. § 103(a) over the combination of *Shiota et al.* in view of *Telle* and *Kondo*.

Applicants respectfully request reconsideration of the rejection of claim 43 under 35 U.S.C. § 103(a) as being unpatentable over *Shiota et al.* in view of *Kondo* and *Liu et al.* Claim 43 ultimately depends from independent claim 38. None of the *Shiota et al.*, *Kondo*, and *Liu et al.* references discloses or suggests the use of image process control information as

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specified in the claimed subject matter. Accordingly, claim 43 is patentable under 35 U.S.C. § 103(a) over the combination of *Shiota et al.* in view of *Kondo* and *Liu et al.*

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of claims 1-71, and submit that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at **(408) 749-6902**. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP005).

Respectfully submitted,
MARTINE PENILLA & GENCARELLA, L.L.P.

A handwritten signature in black ink, appearing to read 'P. B. Martine', with a long horizontal line extending to the right.

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